



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,871	01/28/2000	Christopher Evans	11714-P02	2773

7590 04/14/2003

Jerry Cohen, Esq.  
Perkins, Smith & Cohen, LLP  
One Beacon Street, Suite 30  
Boston, MA 02108-3106

EXAMINER

ARYANPOUR, MITRA

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/493,871

Applicant(s)

EVANS ET AL.

Examiner

Mitra Aryanpour

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (4,147,353) in view of Sowards (4,720,095) and Ainscough et al (5,957,789).

Moore shows an apparatus for holding a soccer ball, comprising: a tie down stake (1) having a lower portion and a circular-shaped upper portion (see figure 1); a ring (2) on the circular-shaped upper portion, wherein the ring (2) is able to travel along a substantial portion of the circular-shaped upper portion; means for (6) securing a soccer ball (8) in a minimally interfering way with kicking, the securing means comprising straps (6a, 6b, 6c, and 6d) for holding the ball (8) tied to a tether line, wherein the tether line has one section which is elastic (4) and attached to the swivel connection (3), and another section that is inelastic (5) and attached to the securing means (straps 6), the tether line being tied at its ends to and extending between the ring and the means for securing (see figure 10); and means for enabling the tether line to rotate about its own axis (3). Moore as disclosed above does not show: 1) the stake to be spiraled, 2) the means for securing the ball to be a net, and 3) the swivel means to be removable.

Sowards shows an apparatus for holding a soccer ball (110), comprising: a tie down stake (112) having a spiraled lower portion (114); a circular-shaped upper portion (118); a handle

Art Unit: 3711

under the circular-shaped upper portion (120) that is projecting from the tie-down stake (112), wherein the handle projects from the stake; a ring (128) on the circular-shaped (118) upper portion, wherein the ring (128) is able to travel along a substantial portion of the circular-shaped (118) upper portion. The ball (110) is attached directly to the ring (128). Figure 10.

Ainscough et al shows a soccer training device, having a ball (12), a tether (16), a detachable link (20) and a hookable/removable swivel-eye bolt (26) attached to an upright (46), (column 2, lines 51-64 and column 3, lines 30-41), wherein the upright (46) is shown to be secured to the ground (59) in several different ways, and wherein the means for securing the ball is a net (14), see figures 1, 4 and 5. It would have been obvious in view of the above teachings to one of ordinary skill in the art at the time the invention was made to have made the following modifications to the apparatus of Moore: 1) to have provided a spiraled stake with a handle as taught by Sowards to provide a more reliable securing means, 2) a removable swivel-eye bolt as taught by Ainscough et al in order to provide an efficient connection and to allow for the ball not only to freely rotate 360 degrees, but to also prevent the cord from winding upon itself; and lastly 3) to provide a net as taught by Ainscough et al so that the ball is able to move more freely within its confines.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 7-11 have been considered but are not persuasive. Regarding applicant's remarks requesting clarification of 103(a) rejection of claims 7-10 over Moore in view of Schachner. The Schachner reference has not been used. The 103(a) rejection is over Moore in view of Sowards and Ainscough et al (a total of three not four references). Regarding applicant's remarks that *no prima facie case was made by a buffet*

Art Unit: 3711

*selection of four references and even if such a case were assumed, it is overcome by the declaration's showing of prior art shortcomings and success of the present invention.* As indicated in the Office Action dated 31 July 2002, the declaration filed 6/18/2002 is insufficient to overcome the rejection of claims 7-10, including newly added claim 11. The affidavit fails to overcome the prima facie case established by the applied prior art. The basis of the rejection of the pending claims was not and is not, one of anticipation (35 USC 102), but rather one of obviousness (35 USC 103), therefore, applicant's remarks that Moore per se does not anticipate the invention and relies on secondary references . . . and all dealt with in the declaration is not understood, since the affidavit has failed to overcome the prima facie case and the rejection is one of obviousness and not anticipation.

In response to applicant's arguments, the recitation of *soccer ball* has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore, applicant's remarks regarding the Schachner reference are moot.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

Art Unit: 3711

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, The Moore reference was modified with Ainscough et al to show that the use of net bags instead of straps are well known, and the Sowards reference was used to show that spiral stakes having handles are old and conventional.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that *the differences between the present invention and the prior art are in the combination of features (with a minimum of four references needed to lay out a "buffet" of the features before combining)*. . . , the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). There is nothing unobvious about combining the aforementioned references, since the combination merely suggests that various means can be employed to achieve the same end result.

Art Unit: 3711

*Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MA  
10 April 2003

  
Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700